

REMARKS

In the August 25, 2005 Office Action, the Examiner noted that claims 1-13 were pending in the application; rejected claims 1-13 under 35 USC § 101; and rejected claims 1-6 and 8-13 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 5,440,624 to Schoof, II; 5,070,470 to Scully et al.; 5,237,499 to Garback; 6,151,575 to Newman et al. (References A-D, respectively in the March 15, 2004 Office Action); and 6,052,680 to Towell (Reference C in the August 25, 2005 Office Action) were cited. Claims 5-8 have been canceled and thus, claims 1-4 and 9-13 remain in the case. The Examiner's rejections are traversed below.

Rejection under 35 U.S.C. § 101

In the last two paragraphs on page 2 of the Office Action, the Examiner rejected claims 1-13 under the 35 USC § 101 because the claims allegedly are "not tangibly embodied in a manner so as to be executable." No support in Title 35 of the U.S. Code or any case decision was provided for such a requirement. Furthermore, no explanation of why "[a] process apparatus, comprising ... a judgment unit calculating" (claim 1, lines 1-3) would not meet this test if it exists. Claim 1 clearly recites an apparatus that includes a unit that is executing an operation. Thus, claim 1 not only recites that the invention is executable, but that it is being executed. Claims 9 and 13 include the same language quoted above from claim 1 and claim 10 recites "[a] process apparatus, comprising ... a communications unit transmitting information" (claim 10, lines 1-4) which also meets the test defining patentable subject matter asserted by the Examiner.

Claim 11 recites "a program enabling a computer to execute a process" (claim 11, lines 1-2) which includes a form of the word used in the test defining patentable subject matter asserted by the Examiner, while claim 12 recites a method of operations that are being executed. Therefore, it is submitted that claims 1 and 9-13, as well as claims 2-4 which depend from claim 1, recite patentable subject matter according to the test asserted by the Examiner, as well as the requirements of 35 U.S.C. § 101.

Rejection under 35 USC § 103(a)

On pages 3-6 of the Office Action, claims 1, 2, 6, 8 and 9-13 were rejected under 35 USC § 103(a) over Schoof, II in view of Towell. Claims 6 and 8 have been canceled and their limitations incorporated into the independent claims as alternative ways to calculate an index or generate an indication, along with the limitations of claim 5 which was not rejected over Schoof, II and Towell and claim 7 which was not rejected over the prior art.

In rejecting claims 6 and 8, column 8, line 5 and Figs. 2, 5 and 6 of Towell were cited. The entire cited line of Towell reads "In the following, an exemplary system for determining". From the quotation marks on page 5 of the Office Action, it will be assumed that the Examiner intended to cite column 8, lines 5-27 of Towell. This paragraph describes a method for "determining whether to route an incoming e-mail to a rule-based system" (column 8, lines 5-6) for "a text to word list translation process" (column 8, line 10) illustrated in Fig. 2. The details illustrated in Fig. 6 all relate to operations on words in e-mails.

As described at column 5, line 59 to column 6, line 42, Fig. 5 is an illustration of the following steps: "determining a relevance value of a preprocessed input message with respect to a decision system, applying a relevance parameter(s) to the determined relevance value, and invoking the decision system if the relevance value meets the relevance parameter(s)" (column 5, lines 60-64). In step 506, "a distance between the vectors is determined ..., [where] the greater the distance between the vectors, the less relevant the message is to the decision system" (column 6, lines 23-25). Step 510 in the flowchart illustrated in Fig. 5 compares the vector distance with a threshold and "if the distance is greater than the predetermined threshold value (assuming higher distance value corresponds to a higher relevance as is the case with a cosine distance value), the input message is provided to the decision system" (column 6, lines).

There is no suggestion in the portion of Towell quoted by the Examiner or the above-quoted more descriptive portions of Towell to base a decision on any "of a number of speakers in the discussion, a number of utterances in the discussion, a depth of a tree structure of the information stored about the discussion and a data amount of the information stored about the discussion" (e.g., claim 1, lines 3-6). Since all of the independent claims contain this list of bases for judging whether to conduct a face-to-face discussion, it is submitted that claims 1, 2 and 9-13 patentably distinguish over Schoof, II in view of Towell.

On pages 7 and 8, claims 3 and 4 were rejected under 35 USC § 103(a) as unpatentable over Schoof, II in view of Towell and further in view of Garback. Nothing was cited or has been found in Garback suggesting modification of the method of routing "an incoming e-mail to a rule-based system" disclosed by Towell to a method of determining when to hold a face-to-face conference based on any of the factors recited on lines 3-6 of claim 1. Since claims 3 and 4 depend from claim 1, it is submitted that claims 3 and 4 patentably distinguish over Schoof, II, Towell and Garback for the reasons discussed above with respect to claim 1.

On page 8, claim 5 was rejected under 35 USC § 103(a) over the same combinations of references and using substantially the same language as used in the March 15, 2004 and January 5, 2005 Office Actions. Claim 5 has been canceled and therefore, this rejection is moot.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-4 and 9-13 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/25/05

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

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STAAS & HALSEY Richard A. Gollhofer
By: Richard A. Gollhofer
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